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REMARKS

A. Request for Reconsideration

Applicant has carefully considered the matters raised by the Examiner in the outstanding Office Action but remains of the position that patentable subject matter is present. Applicant respectfully requests reconsideration of the Examiner's position based on the enclosed Rule 131 Declaration, the copy of JP 2003-186235 with certified English translation, the two Terminal Disclaimers, amendments to the claims and the following remarks.

B. Claim Status and Amendments

Claims 1-11 and 19-21 are presented for further prosecution. Claims 19-21 have been added by this amendment.

New claim 19 recites that the 50% volume particle diameter Dv50 is 3-7  $\mu\text{m}$ . Support for this claim can be found in par. 1 on page 23.

New claims 20 and 21 recite that the toner includes a crystalline ester compound of formula (1). Support for claims 20 and 21 can be found in par. 1 on page 26.

C. Claim Rejections under 35 U.S.C. § 112

Claim 18 had been rejected because the "image" lacks antecedent basis. Claim 18 has been cancelled.

D. Double Patenting Rejections

Claims 1-18 had been rejected for non-statutory obviousness-type double patenting as being unpatentable over claims 1-12 of Yamazaki (U.S. 6,689,522). Claims 1-18 had also been rejected for non-statutory obviousness-type double patenting as being unpatentable over claims 1-15 of Matsushima (U.S. 6,902,856).

Applicant has enclosed two Terminal Disclaimers to overcome the double patenting rejections. The Terminal Disclaimer fees are being provided herewith.

E. Claim Rejections under 35 U.S.C. § 103

Claims 1-18 had been rejected as being unpatentable over Yamazaki in view of either Haneda (U.S. 5,840,461) or Kobayashi (U.S. 5,888,684). Claims 1-18 had also been rejected as being unpatentable over Matsushima in view of either Haneda or Kobayashi.

1. The subject matter of the rejected claims was invented at least as early as December 21, 2001

Applicant has enclosed a Rule 131 Declaration to demonstrate that the subject matter recited in the claims of the present application was invented at least as early as December 21, 2001.

As stated in paragraphs 3-4 of the enclosed declaration, Mr. Kageyuki Tomoyori (the inventor of the present invention) invented the subject matter claimed in the present application at least as early as December 21, 2001. To evidence this fact, Applicant has enclosed a copy of Japanese publication No. JP 2003-186235A (JP '235A), which was filed in Japan on December 21, 2001. A certified English translation of JP '235A is also enclosed.

The JP '235A publication is a publication of Applicant's invention. The subject matter of the claims of the present application are supported in the following portions of JP '235A:

Claim of US App.	Support in JP '235A
1	claim 1
2	claim 2
3	claim 3
4	claim 4
5	par. 20
6	par. 20
7	par. 62
8	Pars. 186-188
9	par. 20
10	par. 20
11	par. 62
19	par. 67
20	pars. 77-78
21	pars. 77-78

As summarized in the above table, the subject matter of claims 1-11 and 19-21 are supported by JP '235A. In addition, Mr. Tomoyori declared in paragraph 5 of the enclosed Rule 131 Declaration that the examples disclosed in the JP '235A

publication (i.e. the JP '232 application) were performed by himself or under his direct supervision and control. Thus, Applicant respectfully submits that the invention recited in the claims of the present application was invented and reduced to practice at least as early as the December 21, 2001 Japanese filing date of JP '235A.

2. The December 21, 2001 date of invention is prior to the effective dates of Yamazaki and Matsushima

MPEP § 715(I) explains that Rule 131 declarations can be used A) to antedate references that qualify as prior art under 102(a) but not 102(b); and B) to antedate references that qualify as prior art under 102(e).

The present application was filed on March 17, 2004. Yamazaki was filed in the US on April 19, 2002 (102(e) date) and published on March 20, 2003 (102(a) date), while Matsushima was filed in the US on December 9, 2002 (102(e) date) and published on August 21, 2003 (102(a) date). Yamazaki and Matsushima are therefore prior art under 102(a) and 102(e), not 102(b).

In accordance with MPEP § 715 (I), Applicant submits that Yamazaki and Matsushima are not prior art because the enclosed Rule 131 declaration establishes a December 21, 2001 date of invention, which is prior to the 102(a) and 102(e) dates of Yamazaki and Matsushima.

Applicant therefore respectfully submits that Yamazaki and Matsushima are not prior art under 102(a), 102(b), or 102(e). It is therefore believed that the obviousness rejections that include Yamazaki and Matsushima are overcome.

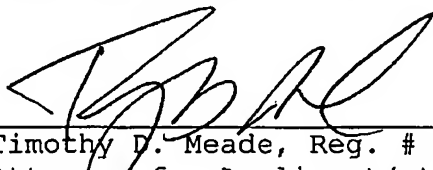
F. Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By:



Timothy D. Meade, Reg. # 55,449  
Attorney for Applicant(s)  
475 Park Avenue South, 15<sup>th</sup> Floor  
New York, NY 10016  
Tel. # 212-661-8000

Encl: Rule 131 Declaration  
JP 2003-186235A  
Certified English translation of JP 2003-186235A  
Two Terminal Disclaimers